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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Todd A. Newville et al.
Serial No. : 10/083,669
Filed : February 26, 2002
Title : INFORMATION DISTRIBUTION SYSTEM FOR USE IN AN ELEVATOR

Art Unit : 2837
Examiner : Anthony Salata

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

18/ Appeal
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BRIEF ON APPEAL

Applicant appeals the final rejection of claims 1 and 55-73 in the final action dated July 17, 2003. A notice of appeal was filed on October 16, 2003.

Applicant requests that the rejection of claims 1 and 55-72 be reversed.

(1) Real Party in Interest

The real party in interest is Captivate Network, Inc., a Delaware corporation having a place of business at 133 Littleton Road, Westford, Massachusetts as evidenced by an assignment executed April 6, 2000 and recorded at the U.S. Patent Office on April 21, 2000, at Reel/Frame 010770/0853.

(2) Related Appeals and Interferences

Neither Applicant, nor Applicant's legal representative, nor the assignee are aware of any appeals or interferences that will directly affect or be affected by or have a bearing on the Board's decision in the pending appeal.

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(3) Status of Claims

Claims 1, and 55-72 are pending and under final rejections. Claims 2-54, and claim 73 have been cancelled.

(4) Status of Amendments

In a response after the final action, Applicant proposed amendments of claims 58, 64, and 68. In the same response, Applicant requested cancellation of claim 73. All amendments have been entered, and claim 73 has been cancelled.

(5) Summary of Invention

The video information to be shown on a publicly viewable video display typically follows a predictable sequence. A display of news headlines may be followed by a display of sports headlines, weather, trivia, celebrity birthdays, and the like. This cycle then repeats itself.

This video information is retrieved from many different sources that are in communication with the processor driving the display. The invention is directed to managing the retrieval of such video information by a network of geographically dispersed displays while still retaining the ability to provide information of local or special interest.

In the claimed method, video information is retrieved by having each processor receive "first data" that defines categories of information. Exemplary categories can include news, weather, trivia, and the like. This "first data" does not, however, tell the processor where to retrieve video information associated with that category. That role is fulfilled by the "second data," which specifies, for each category, precisely where the video information for that category is to be obtained. Having received the first and second data, the processor is now in a position to actually retrieve the video information over a data communication path. This process is described between lines 5 and 22 on page 8 of the specification.

The claimed method thus separates the type of information to be displayed (i.e. the "category") from the actual source of that information. This separation simplifies the task of providing special or local interest programming to selected subsets of the displays. For example,

one can transmit the same first data to all displays indicating that weather is to be displayed, but then transmit different second data to different displays, thus causing displays to retrieve video weather information from different locations.

The method of the invention can be used to control the display of video information in an elevator-mounted display. However, there is nothing about the claimed method that requires the display to be in an elevator. The invention is in fact a method for easing the task of managing the display of video information across thousands of displays. Some of these displays may be in elevators, but many others may not be.

(6) Issues

At issue in this appeal is:

1. Whether the pending claims recite subject matter that is identical to that recited in the claims of *Newville*.

(7) Grouping of Claims

Group I: Independent claim 1 and dependent claims 55-61

Group II: Independent claim 62 and dependent claims 63-65

Group III: Independent claim 66 and dependent claims 67-70

Group IV: Independent claim 71 and dependent claim 72

(8) Argument

A statutory double-patenting rejection is proper only when exactly the same invention is being claimed twice.¹ In this context, "same invention" means that *exactly* the same subject matter is being claimed twice.² Therefore, to the extent that there is even the slightest difference

¹ MPEP 804(II)(A), citing *In re Vogel* 422 F.2d 438, 441 (1970) ("In determining whether a statutory basis for a double-patenting rejection exists, the question to be asked is: Is the same invention being claimed twice?")

² *In re Vogel*, at 441 ("By 'same invention' we mean identical subject matter. Thus the invention defined by a claim reciting 'halogen' is not the *same* as that defined by a claim reciting 'chlorine,' because the former is broader than the latter"). [*Emphasis in original*]

in the claimed subject matter, a statutory double-patenting rejection under 35 USC 101 is improper.

For convenience, the following text shows amendments that must be made to claim 1 of *Newville* to arrive at pending claim 1.

1. *A method of providing video information to a display monitor ~~within an elevator located in a building~~, the method comprising:*

receiving first data defining a category of video information; ~~the first data being source non-specific~~;

receiving second data, associated with the category of video information and defining at least one source of the video information; and

retrieving from the source, over a data communications path, and on the basis of first data and second data, the video information to be displayed on the monitor ~~with the elevator~~.

Claim 1 of *Newville* thus requires that the display monitor be within the confines of an elevator. As noted by the Examiner, pending claim 1 removes this limitation.³ Thus, the Examiner plainly agrees that claim 1 of *Newville* and pending claim 1 cover different subject matter. This alone is enough to obviate the double-patenting rejection.⁴

As additional guidance, the MPEP proposes the following test for double patenting:

*"[a] reliable test for double-patenting under 35 USC 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent"*⁵

³ *Final Office Action*, July 17, 2003, page 3 ("The instant claims merely delete references to the environment ("elevator") from 6,349,797.

⁴ *In re Kaplan*, 789 F.2d 1574, 1577-78 (CAFC 1986) in which the Court reversed the board in part because "[i]t has confused double patenting with 'domination' which, by itself, does not give rise to 'double patenting'".

⁵ MPEP 804(II)(A), citing *In re Vogel*, 422 F.2d 438,441 (CCPA 1970). ("A good test, and probably the only objective test 'for same invention,' is whether one or more claims could be

Under this test, the double-patent rejection is clearly improper. For example, one might attempt to avoid claim 1 of *Newville* by the simple expedient of moving the display monitor to the elevator lobby, for example, rather than within the elevator itself. This attempt to avoid *Newville*'s claim 1 would be thwarted by pending claim 1, which recites no such limitation on the location of the display monitor. It is therefore possible to infringe pending claim 1 without infringing *Newville*'s claim 1.

In maintaining the propriety of the statutory double-patenting rejection, the Examiner's position appears to be that: (1) the specification does not explicitly teach the placement of the display in a location other than the elevator; and (2) that the limitation of an elevator is added back in by dependent claims. These facts, even if true, are irrelevant to a rejection under 35 USC 101. The only issue raised in a statutory double-patenting rejection is whether, despite their clear textual differences, pending claim 1 and claim 1 of *Newville* somehow manage to cover *identical* subject matter. But as the Examiner himself has admitted, pending claim 1 is different from *Newville*'s claim 1.

Claims 36, 47, and 53 of *Newville* differ from pending claimed 62, 66, and 71 in the same manner as set forth above in connection with claim 1. None of the pending claims limit the display to being in an elevator. In contrast, each claim in *Newville* recites this limitation. Consequently, it is logically impossible to identify a pair of claims, one from the pending claims and the other from *Newville*, that recite identical subject matter. Accordingly, a statutory double-patenting rejection of any of the pending claims is improper for at least the same reasons as set forth in connection with claim 1.

literally infringed without infringing the other. If it could be, the claims do not define identically the same invention.”).

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The brief fee of \$165 is enclosed. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: October 28, 2003



Faustino A. Lichauco
Reg. No. 41,942

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Appendix of Claims

1. (Previously Presented) A method of providing video information to a display monitor, the method comprising:

receiving first data defining a category of video information;

receiving second data, associated with the category of video information and defining at least one source of the video information; and

retrieving from the source, over a data communications path and on the basis of the first data and the second data, the video information to be displayed on the display monitor.

2-54 (cancelled)

55. (Previously Presented) The method of claim 1, wherein the first data is a generic play list having a plurality of entries, each entry defining a category of video information.

56. (Previously Presented) The method of claim 55, wherein each entry in the generic play list defines a time segment during which the video information is to be displayed.

57. (Previously Presented) The method of claim 55, wherein the generic play list is selected from one of a plurality of play lists.

58. (Previously Presented) The method of claim 1, further comprising generating a local play list having a plurality of entries including advertisement information.

59. (Previously Presented) The method of claim 1, wherein the display monitor is located in a personnel transport vehicle having an occupancy detector, the method further comprising:

accumulating advertisement impression information with the occupancy detector; and

generating, based on the advertisement impression information, a local building play list having a plurality of entries including advertisement information.

60. (Previously Presented) The method of claim 1, wherein the server is located in a building housing the display monitor.

61. (Previously Presented) The method of claim 1, wherein the display monitor is located in a personnel transport vehicle.

62. (Previously Presented) A method comprising:

creating a generic play list including categories of video information and time segments associated with each category of information;

associating path information with the categories of information in the generic play list to create a content mapping file;

requesting files accessing data sources using path information in the content mapping file;

downloading requested files to build category file lists with pointers to files accessing the data sources in each category of video information;

placing the categories in the category file lists into the time segments in the generic play list;

filling the files in the category file lists into the categories in the generic play list to create a content play list;

adding local building information to the content play list to create a local play list; and

distributing the video information to a display monitor of the local play list.

63. (Previously Presented) The method of claim 62, wherein the downloaded files are provided within a protocol header.

- 64. (Previously Presented)** The method of claim 62, wherein the processor is in a personnel transport vehicle.
- 65. (Previously Presented)** The method of claim 62, wherein the display monitor is located in a personnel transport vehicle having an occupancy detector, the method further comprising:
- accumulating advertisement impression information with the occupancy detector;
 - generating, based on the advertisement impression information, an advertisement play list having a plurality of entries including advertisement information; and
 - adding the advertisement play list to the content play list to create the local play list.
- 66. (Previously Presented)** A method for providing video information to a display monitor, the method comprising:
- creating a generic play list including categories of video information associated with each category of information;
 - associating path information with the categories of information in the generic play list to create a content mapping file;
 - requesting files accessing data sources using path information in the content mapping file;
 - downloading requested files to build category file lists with pointers to files accessing the data sources in each category of video information, wherein the category file list includes status information for each downloaded file; and
 - activating, deactivating or removing a file from a local building play list based on the status information in the category file list.
- 67. (Previously Presented)** The method of claim 66, wherein the files are downloaded to a processor in a building housing the display monitor.

68. (Previously Presented) The method of claim 66, wherein the processor is in a personnel transport vehicle.

69. (Previously Presented) The method of claim 66, further comprising:

placing the categories in the category file lists into a time segments in the generic play list for each category; and

filling the files in the category file lists into the categories in the generic play list to create a content play list.

70. (Previously Presented) The method of claim 66, wherein the display monitor is located in a personnel transport vehicle having an occupancy detector, the method further comprising:

accumulating advertisement impression information with the occupancy detector;

generating, based on the advertisement impression information, an advertisement play list having a plurality of entries including advertisement information; and

adding the advertisement play list to the content play list to create the local play list.

71. (Previously Presented) A system for providing video information to a display monitor, the system comprising:

a display unit having a display monitor to display the video information; and

a processor which retrieves, over a data communications path, the video information from a source, the processor retrieving the video information on the basis of first data defining a category of source non-specific video information and second data which defines a source of the video information defines and is associated with the category of video information.

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72. (Previously Presented) The system of claim 71, wherein the display monitor is positioned within a personnel transport vehicle to display the video information to passengers within the personnel transport vehicle.

73. (Cancelled).